

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

AF/GP-2712
#17
W. Lawson
6/17/99

In re the Patent Application of)

Yutaka Nakatsu ET AL.)

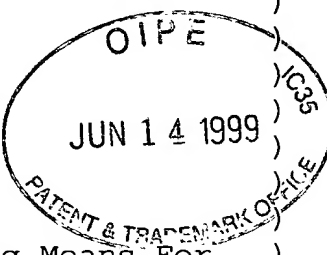
Serial No. 08/610,758)

Filed: March 5, 1996)

For: Apparatus Having Means For)
Printing Video Signals of)
Video Camera Attached)
Thereto)

Examiner: A. Moe

Art Unit: 2712



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REPLY BRIEF

Assistant Commissioner of Patents
BOX AF
Washington, DC 20231

Sir:

I. Introduction

This Reply Brief is filed pursuant to Rule 193(b)(1) in response to the Examiner's Answer mailed on April 16, 1999. Review and reconsideration of the claims pending in this Appeal in light of this Reply Brief are respectfully requested.

Only one issue is presented by this Appeal, i.e., whether claims 1-7 were properly rejected as allegedly being unpatentable under 35 USC § 103(a) over U.S. Patent

No. 4,937,676 issued to Finelli (hereinafter "Finelli") in view of U.S. Patent No. 5,621,492 issued to Beveridge (hereinafter "Beveridge"), resolution of which requires a determination of whether Finelli in view of Beveridge teaches or suggests the claimed invention. Prior reference to the Brief on Appeal, its Appendices, and the record is assumed.

Before turning to the substance of this Reply Brief, Appellant wishes to thank the Examiner for the interview of June 9, 1999. During the interview, the Examiner and Attorney Loletta L. Darden discussed the scope of the teachings of Finelli and Beveridge and the differences between the invention as claimed. Additionally, during the interview, the Examiner stated that in accordance with Patent Office procedure, he would be amenable to considering an amendment of the claims as part of a response to his Answer. Therefore, Appellant sets forth a proposed amendment in section III of this reply.

II. Response To The Examiner's Answer

Turning now to the substance of the Examiner's Answer, while the Examiner's Answer was thorough and well reasoned, the analysis fails to meet the burden of showing that the

limitations of the claims are obvious over Finelli in view of Beveridge.

Appellant agrees with the Examiner that Finelli discloses the use of a still picture camera that may be connected to a video printer for printing as a hard copy a video image captured by the camera. (col. 6, lines 55-65). Appellant further agrees with the Examiner that "Finelli ... does not explicitly show the use of a video camera which is capable of capturing continuous motion images, so that one video picture from a plurality of continuous video pictures can be selected." (Examiner's An. at p. 5).

Thus, the Examiner cites Beveridge for its disclosure of a video camera for capturing continuous motion images. (Id.). The Examiner opines that "[i]n this way, the user can **select** a single desired video image from the continuous sequence of video images captured by the video camera ..." (Id.) (emphasis added).

The question is selection for what? In Beveridge, the video camera allows a user to view current or past poses in anticipation of a "picture taking moment." (See Beveridge, col.4, lines 8-56). Once a desired pose is achieved or selected, that pose is either held, if the current pose displayed, or reconstructed, if a previously recorded pose. Thereafter, Beveridge permits the user to record the

desired image by capturing a "still picture" of himself in the desired pose. (See *Id.*).

In the claimed invention, the image is selected from recorded images for the purpose of printing, not for viewing, reconstructing the image, photographing and then printing as in Beveridge.

Beveridge simply does not teach printing an image selected from "the continuous sequence of video images captured by the video camera" as stated by the Examiner. Nor does the combination of Finelli and Beveridge teach this limitation of Appellant's claims. Consequently, the combined teachings of Finelli and Beveridge do not suggest each of the limitations of the claimed invention.

III. Proposed Amendment

Alternatively, should the Board determine that the Examiner has properly construed the teachings of Beveridge, Appellant proposes the following amendment to the claims, this amendment being made in view of the Examiner's assertion that in accordance with Patent Office procedure he would be amenable to reviewing an amendment at this time:

1. (Twice Amended) A video printer for printing on a printing paper as a hard copy a prerecorded video picture

selected from a plurality of video pictures prerecorded
[recorded] by a video camera as continuous motion images,
said printer comprising:

a video printer housing portion with a video camera
attached thereto;

a signal input and output connection terminal disposed
on said video printer housing portion for electrically
connecting said video camera attached to said video printer
housing portion to said video printer; and

an operation system disposed on said video printer
housing portion for operating said video camera.

4. (Three Times Amended) A video printer
according to claim 1, wherein said video camera operation
system includes a shuttle ring for displaying on the
picture screen of said liquid-crystal display in a play
mode, pause mode, fast-forward mode or rewind mode a video
picture prerecorded [recorded] as continuous motion images.

5. (Three Times Amended) A video printer
according to claim 1, wherein said video camera operation
system includes a memory operation means for storing video
data indicative of a video picture selected from said
plurality of video pictures prerecorded [recorded] as
continuous motion images by said video camera in a memory
of said video printer.

Remarks Concerning Proposed Amendment

The combination of Finelli and Beveridge does not teach or suggest printing an image selected from a plurality of images prerecorded by a video camera as a continuous motion image. Rather each reference discloses printing an image that has been recorded or prerecorded as a "still image" (Finelli) or viewed as part of plurality of images recorded continuous motion images and printed using still picture photography of the type taught by Finelli (Beveridge).

CONCLUSION

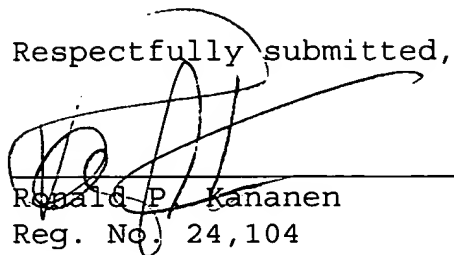
In view of the foregoing remarks, claims 1-7 are patentable over the combination of Finelli and Beveridge without any amendment of the claims.

Alternatively, the proposed amendment places the claims in condition for allowance. Thus, Appellant respectfully requests entry of the amendments to the claims, if necessary, and withdrawal of the rejection under 35 U.S.C. § 103(a). No fee is believed to be due upon submission of the proposed amendment. However, the undersigned authorizes the Commissioner of Patents and Trademarks to charge any fees due to Deposit Account 18-0013.

Please direct any questions or inquiries to the below
named attorney..

Respectfully submitted,

Dated: June 14, 1999



Ronald P. Kananen
Reg. No. 24,104

Rader, Fishman & Grauer PLLC
1233 20th Street, N.W., Suite 501
Washington, D.C. 20036
Tel: (202) 955-3750
Fax: (202) 955-3751
r0056903